

Appl. No.: 09/920,888
Amdt. dated 03/02/2006
Reply to Office Action of 12/02/2005

REMARKS

This amendment is submitted with a Request for Continued Examination in response to the final Office Action dated December 2, 2005.

Claims 7-10 currently stand rejected. Applicants have amended independent claims 7, 8 and 10 to more particularly distinguish the claimed invention from the cited references. No new matter has been added by the amendment. Previously withdrawn claims 1-6 and 11 have been canceled, without prejudice.

In light of the amendment and the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present invention.

Claim Rejections - 35 USC §103

Claims 7-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ogasawara (U.S. Patent No. 6,512,919) in view of Bhogal et al. (U.S. Patent No. 6,751,298, hereinafter "Bhogal").

I. Bhogal is not analogous art.

The claimed invention is generally directed to systems and devices for mobile browsing such that a portable radio communication device can communicate an identity tag having address information for a remote server or terminal to which an object device receiving the identity tag can download information. The Office Action cites Ogasawara as the primary reference, but admits that Ogasawara fails to teach or suggest downloading information via a network to a remote server or terminal in accordance with address information associated with the identity tag. Accordingly, the Office Action cites Bhogal as teaching such feature. However, Bhogal is not a proper reference since Bhogal relates to non-analogous art.

The secondary reference Bhogal merely describes a localized voice mail system. In particular, Bhogal describes that voice mail messages may be stored on a server of a cellular network or of a telephone network service subscriber (col. 2, lines 14-25). Accordingly, a cellular telephone can retrieve voice mail messages even when the cellular telephone is roaming or cannot pickup a carrier signal (Abstract).

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Applicants respectfully submit that Bhogal is not a proper reference because Bhogal describes nonanalogous art. To rely on a reference under 35 U.S.C. §103, it must be analogous prior art. See MPEP 2141.01(a). The two-part test for analogous art requires that “the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *State Contracting & Eng’g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where if the general scope of a reference is outside the pertinent field of endeavor, the reference may still be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved). As stated above, Bhogal is directed to a method for storing voice mail messages at a remote server. The problem to be addressed by Bhogal is allowing a cellular telephone to access voice mail messages while roaming or unable to pick up a carrier signal. To the contrary, the claimed invention is directed to mobile browsing. Conversely, the problem to be addressed in the art of the claimed invention is developing a way to allow an object device to download information to a remote server identified by an identity tag sent from a portable radio communication device. Bhogal, on the one hand, and the present application, on the other hand, are simply not in the same field of endeavor since mobile browsing and voice mail are quite clearly unrelated fields of endeavor. Additionally, there would be no reason for one skilled in the art faced with the problem of developing a way to allow an object device to download information to a remote server identified by an identity tag sent from a portable radio communication device to consider a method of storing voice mail messages at a remote server pertinent. Therefore, Bhogal not reasonably pertinent to the particular problem with which the inventor was concerned. Thus, Bhogal is not analogous art and, therefore, cannot be relied upon to support an obviousness rejection under 35 U.S.C. §103.

In a telephone interview with the Examiner on February 22, 2006, the Examiner argued that since the claims recite a “downloading of information”, that it would be proper to use any reference which teaches a downloading of any information including voice mail messages. Applicants respectfully submit that this is not a permissible interpretation with respect to criteria for an appropriate reference under 35 U.S.C. §103. As stated above, MPEP 2141.01(a) specifies

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that in order to rely on a reference under 35 U.S.C. §103, it must be analogous prior art. Although the Examiner is entitled to take the broadest reasonable interpretation of claim elements when comparing a prior art reference to a claimed invention, this entitlement does not vest until the Examiner has first identified a proper prior art reference.

Since Bhogal is not analogous art, Bhogal is not a proper reference. Accordingly, since Ogasawara alone fails to teach or suggest at least downloading information via a network to a remote server or terminal in accordance with address information associated with the identity tag as admitted in the Office Action, the claimed invention is patentable over Ogasawara. Thus, the rejections of claims 7-10 are overcome.

II. There is no motivation to combine the references.

Furthermore, Applicants submit that there is no motivation to combine the references. In this regard, a teaching or motivation to combine the references is essential in order to properly combine references. *In re Fine*, 337 F.2d 1071, 1075 (Fed. Cir. 1988). In fact, the Court of Appeals for the Federal Circuit has stated that, “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight.” *In re Dembicza*, 175 F.3d 994 (Fed. Cir. 1999). Although the evidence of a suggestion, teaching, or motivation to combine the references commonly comes from the prior art references themselves, the suggestion, teaching, or motivation can come from the knowledge of one of ordinary skill in the art or the nature of the problem to be solved. *Id.* In any event, the showing must be clear and particular and “[b]road conclusory statements regarding the teaching effect of multiple references, standing alone, are not ‘evidence’.” *Id.* The final Office Action states that the motivation for modifying Ogasawara to include the teachings of Bhogal would be in order to retrieve a message for later use. However, the Applicants respectfully submit that such statement is merely a broad conclusory statement which, standing alone, is not “evidence”, as required under the patent laws, of motivation to combine the cited references. Such a broad statement does not provide evidence of motivation for one seeking to download information via a network to a remote server or terminal in accordance with address information associated with

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the identity tag to look to the art of voice mail systems. Accordingly, Applicant respectfully submits that there is no motivation to combine the references.

Since there is no motivation to combine the references, it is respectfully submitted that the rejections of all claims based on the combination of these references is overcome.

II. The references fail to meet the amended claims.

Even assuming that the cited references are proper and that the cited references can be properly combined (assumptions with which the Applicants expressly disagree), the cited references still fail to meet the amended claims. Independent claims 7, 8 and 10 have been amended to recite, *inter alia*, that the processor authorizes the downloading of information via the network to a remote server or terminal identified by address information associated with the identity tag.

As stated above, Ogasawara fails to teach or suggest that the processor authorizes the downloading of information via the network to a remote server or terminal identified by address information associated with the identity tag as claimed in independent claims 7, 8 and 10. Furthermore, Ogasawara is not cited as teaching such feature.

Meanwhile, Bhogal discloses that the remote server accesses voice mail messages for a cellular telephone based on the cellular telephone number. Thus, Bhogal fails to teach or suggest that the remote server is identified by address information associated with the telephone number. Accordingly, Bhogal fails to teach or suggest that the processor authorizes the downloading of information via the network to a remote server or terminal identified by address information associated with the identity tag as claimed in independent claims 7, 8 and 10.

Since neither Ogasawara nor Bhogal alone teach or suggest that the processor authorizes the downloading of information via the network to a remote server or terminal identified by address information associated with the identity tag as claimed in independent claims 7, 8 and 10, any combination of the cited references likewise fails to render independent claims 7, 8 and 10 obvious for at least the same reasons described above. Claim 9 depends directly from independent claim 8, and thus includes all the recitations of independent claim 8. Therefore, dependent claim 9 is patentable for at least those reasons given above for independent claim 8.

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Accordingly, for all the reasons stated above, Applicant respectfully submits that the rejections of claims 7-10 are overcome.

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CONCLUSION

In view of the amendment and the remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

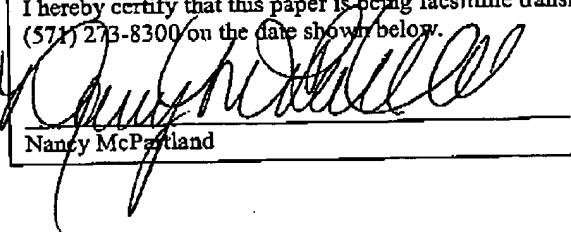


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